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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,665	09/25/2001	Peter Becker	48498-0120(2)	6282

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JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER

NGUYEN, BAO THUY L

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 10/06/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,665

Applicant(s)

BECKER ET AL

Examiner

Nelson Yang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-124 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 28-124 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

2. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 28-58, drawn to a method for the detection of analytes in a sample using a nucleic acid hybridization assay.

Group II, claim(s) 28-58, drawn to a method for the detection of analytes in a sample using a lectin-sugar assay.

Group III, claim(s) 28-58, drawn to a method for the detection of analytes in a sample using a protein-nucleic assay.

Group IV, claim(s) 28-58, drawn to a method for the detection of analytes in a sample using a combination of a nucleic acid hybridization assay, lectin-sugar assay, and protein-nucleic assay.

Group V, claim(s) 28-58, drawn to a method for the detection of analytes in a sample where changes are caused by latex beads.

Group VI, claim(s) 28-58, drawn to a method for the detection of analytes in a sample where changes are caused by plastic beads.

Group VII, claim(s) 28-58, drawn to a method for the detection of analytes in a sample where changes are caused by glass beads.

Group VIII, claim(s) 28-58, drawn to a method for the detection of analytes in a sample where changes are caused by metal beads.

Group IX, claim(s) 28-58, drawn to a method for the detection of analytes in a sample where changes are caused by combination of latex, plastic, glass and metal beads.

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Group X, claim(s) 59-91, drawn to a support for the detection of analytes in a sample using a nucleic acid hybridization assay.

Group XI, claim(s) 59-91, drawn to a support for the detection of analytes in a sample using a lectin-sugar assay.

Group XII, claim(s) 59-91, drawn to a support for the detection of analytes in a sample using a protein-nucleic assay.

Group XIII, claim(s) 59-91, drawn to a support for the detection of analytes in a sample using a combination of a nucleic acid hybridization assay, lectin-sugar assay, and protein-nucleic assay.

Group XIV, claim(s) 59-91, drawn to a support for the detection of analytes in a sample where changes are caused by latex beads.

Group XV, claim(s) 59-91, drawn to a support for the detection of analytes in a sample where changes are caused by plastic beads.

Group XVI, claim(s) 59-91, drawn to a support for the detection of analytes in a sample where changes are caused by glass beads.

Group XVII, claim(s) 59-91, drawn to a support for the detection of analytes in a sample where changes are caused by metal beads.

Group XVIII, claim(s) 59-91, drawn to a support for the detection of analytes in a sample where changes are caused by combination of latex, plastic, glass and metal beads.

Group XIX, claim(s) 92-124, drawn to a method of making a support for the detection of analytes in a sample using a nucleic acid hybridization assay.

Group XX, claim(s) 92-124, drawn to a method of making a support for the detection of analytes in a sample using a lectin-sugar assay.

Group XXI, claim(s) 92-124, drawn to a method of making a support for the detection of analytes in a sample using a protein-nucleic assay.

Group XXII, claim(s) 92-124, drawn to a method of making a support for the detection of analytes in a sample using a combination of a nucleic acid hybridization assay, lectin-sugar assay, and protein-nucleic assay.

Group XXIII, claim(s) 92-124, drawn to a method of making a support for the detection of analytes in a sample where changes are caused by latex beads.

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Group XXIV, claim(s) 92-124, drawn to a method of making a support for the detection of analytes in a sample where changes are caused by plastic beads.

Group XXV, claim(s) 92-124, drawn to a method of making a support for the detection of analytes in a sample where changes are caused by glass beads.

Group XXVI, claim(s) 92-124, drawn to a method of making a support for the detection of analytes in a sample where changes are caused by metal beads.

Group XXVII, claim(s) 92-124, drawn to a method of making a support for the detection of analytes in a sample where changes are caused by combination of latex, plastic, glass and metal beads.

3. The inventions listed as Groups I-XXVII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The application contains claims to more than one of the combinations of categories of inventions as set forth by 37 CFR 1.475.

According to 37 CFR 1.475 regarding unity of invention:

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

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(4) A process and an apparatus or means specifically designed for carrying out the said process;
or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) above, unity of invention might not be present. Furthermore, the determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

4. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on the contents of the claims as interpreted in light of the description and drawings. In the instant application, Groups I-IX, X-XVIII, and XIX-XVII have differing special technical features as listed above:

5. Furthermore, the apparatus of groups IX-XVIII has been taught by Virtanen [US 6,030,581] for assay purposes such as oligonucleotide analysis.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson Yang whose telephone number is 703-305-4508. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V Le can be reached on 703-305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

NY



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

10/02/03